

The opinion in support of the decision being entered today  
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MELISSA SILVESTRO, JOSEPH P. KING, JR.,  
JOSEPH P. DEYESO, ALBERT F. BEINOR, JR.,  
LAWRENCE J. FEROLI, and JOSEPH L. BRIGHAM, JR.

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Appeal 2006-2289  
Application 10/812,266  
Technology Center 3600

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Decided: August 31, 2007

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Before WILLIAM F. PATE, III, HUBERT C. LORIN, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, and 9. These are the only claims that remain in the application. We have jurisdiction under 35 U.S.C. §§ 134 and 6.

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The claimed invention is directed to a threaded fastener for two types of electronic equipment mounting rails. The fastener has a circular stepped portion on the bottom planar surface of the head. The stepped portion is sized so it will just fit in the square hole of the second type of mounting rail.

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A fastener, comprising:
  - a shank having a threaded portion;
  - a head portion having a top surface, a planar bottom surface, and a diameter, and
    - a stepped portion between the head portion and the threaded portion, the stepped portion having a diameter that is larger than the diameter of a round hole in a first type of mounting rail and smaller than a length of a side of a square hole in a second type of mounting rail, wherein when the fastener is inserted into one of the round holes of the first type of mounting rail a bottom surface of the stepped portion is urged against a front surface of the first type of mounting rail, and when the fastener is inserted into one of the square holes of the second type of mounting rail the stepped portion enters closely into the square hole and the planar bottom surface of the head portion is urged against a front surface of the second type of mounting rail.

The reference of record relied upon by the Examiner as evidence of obviousness is:

Drake

US 6,746,193 B1

Jun. 8, 2004

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Claims 1, 2, and 9 stand rejected under 35 U.S.C § 103 as unpatentable over Appellants' admitted prior art in view of Drake.

## OPINION

We reverse the rejection of claims 1, 2, and 9 on appeal. Assuming *arguendo* that the teaching of the locating surface 110 on the nut disclosed in Drake would have suggested the use of a locating surface on a fastener head as claimed, that still leaves the matter that the locating surface 110 is disclosed as square-shaped in the Drake reference. While we note that the stepped portion is claimed as circular in claim 2, we note that the stepped portion is claimed with a given diameter in claim 1. Thus, in all claims on appeal the stepped portion is at least inferentially of a rounded shape. It is for this reason, that even if we assume the obviousness of transferring a locating surface from a nut to a fastener head, we can not agree that the square locating surface suggests the round one claimed by the Appellants.

## REMAND

This application is hereby remanded to the Examiner for findings of fact and conclusions of law with respect to the following Mayer reference and the claimed subject matter on appeal. The following reference is to be analyzed with respect to the claimed subject matter:

Mayer US 6,578,939 B1 Jun. 17, 2003

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The Examiner shall make findings of fact and conclusions of law with respect to the Figures 7 and 8 embodiment of Mayer and whether the washer 702 along with the screw 608 would have rendered the subject matter of claims 1, 2, and 9 *prima facie* obvious to one of ordinary skill.

#### CONCLUSION AND ORDER

The rejection of claims 1, 2, and 9 is reversed. The application is remanded to the Examiner for findings of fact and conclusions of law with respect to the Mayer reference.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1)(effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this Remand by the Board.

REVERSED; REMANDED

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